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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,539	08/14/2001	Rodney M. LaFollette	7310.C	7186

7590 04/17/2006

Foster & Foster, LLC
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Communication Re: Appeal

Application No.

09/930,539

Examiner

Raymond Alejandro

Applicant(s)

LAFOLLETTE ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ The Notice of Appeal filed on 06 December 2004 is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 41.20(b)(1).
- (c) ☐ the appeal fee received on _____ was not timely filed.
- (d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 41.20(b)(1) is \$_____.
- (e) ☒ the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.

2. ☐ The appeal brief filed on _____ is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 41.37(a).
- (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 41.20(b)(2).
- (c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 41.20(b)(2) is \$_____.

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. See 37 CFR 41.37(a)(1). Extensions of time may be obtained under 37 CFR 1.136(a). See 37 CFR 41.37(e).

3. ☐ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 41.20(b)(2) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (c) ☐ a Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.
- (d) ☐ other: _____.

4. ☐ Because of the dismissal of the appeal, this application:

- (a) ☐ is abandoned because there are no allowed claims.
- (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration.


PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER

DETAILED ACTION

This Notification of Defective Appeal Brief is being provided in response to the Appeal Brief filed on 12/06/04.

In this regard, it is noted that under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally...rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application (*See MPEP 1205 Notice of Appeal*).

In this instance, the present appeal brief fails to meet the requirement of having the claims twice rejected simply because the appealed claims and their intended subject matter have not been twice rejected by the examiner. That is to say, the intended amendment of 10/14/04, the substitute amendment of 11/01/04, and the supplemental amendment of 11/09/04 incorporating new limitations into the claims (*i.e. the specific foot print area as low as 0.001 cm^2 in claim 21; and the specific footprint within a range of less than 1 cm^2 to 0.0001 cm^2 and the connotation of the micro-fabricated limitation in claim 33*) were never made of record and officially entered due to its non-compliant condition as set forth in various Notices of Non-Compliant Amendment

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dated 10/22/04 and 11/15/04 identifying the lack of a complete listing of all of the claims, and/or in the Failure to Acceptably Respond to Notice of Non-Compliant Amendment of 11/23/04. The foregoing non-compliant communications were issued by the Technical Support Team of PTO, and they do not reflect, in any way, an official examination on the merits of claims. Thus, since the appealed claims include non-entered amendments and unexamined subject matter, it is contended that the appealed claims have not been considered and examined on their merits. Additionally, the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected. That is to say, the appeal brief is premature because the present claims on appeal have not been twice rejected in their entirety. In other words, the present claims contain newly added subject matter that has not been addressed or considered by the examiner.

In consequence, the appeal brief is defective as it unfairly appeals subject matter not twice rejected or considered by the examiner; and ultimately, never considered and examined on the merits by the examiner. To remedy this defectiveness, applicant is suggested to either: a) cancel or delete the newly added limitations (the limitations newly added in the amendment not-entered) so as to fairly appeal the examiner's rejection based on the original claimed subject matter of the current application; or b) withdraw the appeal brief and allow the application to continue its regular course of action and examination. If applicant desires to adopt any of aforementioned suggestions or any other action, applicant is still reminded of his obligation to submit a proper reply addressing this issue so as to avoid an abandonment due to applicant's failure to offer a proper reply timely filed.